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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JACOBS, LASHONDA T

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,689

Applicant(s)

MENU, MICHEL

Examiner

LaShonda T Jacobs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 16, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Response to Amendment***

This is a Final Office Rejection in response to Applicant's Amendment filed on December 16, 2004. Claims 1-8 have been amended and are presented for further examination. Newly added claims 9-10 by Applicant are also presented for examination.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 3-6 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe et al (hereinafter, "Watanabe" U.S. Pat. No. 6,014,687).

As per claim 3, Watanabe discloses a process for effecting communication between at least two communication terminals across a computer network, in which the two terminals being linked to a telephone network, comprising:

- the terminals are linked to a telephone network (see Figure 3 and col. 4, lines 8-22);
- a first of the terminals connects to the computer network and obtains a first computer address which is transmitted to a second terminal across the telephone network (col. 4, lines 46-67 and col. 5, lines 1-11), and

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- the second terminal connects to the computer network and obtains a second computer address which is transmitted to the first terminal across the computer network (col. 5, lines 1-11 and lines 21-31),
- wherein after having obtained the first computer address, the first terminal disconnects from the computer network, so as to transmit the first computer address to the second terminal across the telephone network, then reconnects to the computer network and obtains the same first computer address as during the previous connection (col. 5, lines 52-65).

As per claim 4, Watanabe discloses:

- after having disconnected from the computer network, the first terminal calls the second terminal across the telephone network so as to transmit the first computer address to the second terminal (col. 5, lines 52-65).

As per claim 5, Watanabe discloses:

- in which the first terminal connects up to the computer network by way of an access provider to which it addresses a request is addressed so as to obtain the same first computer address for two successive connections (col. 5, lines 52-65).

As per claim 6, Watanabe discloses:

- in which the first terminal connects up to the computer network which allocates it the by way of an access provider same first computer address to the first terminal for a plurality of successive connections in so far as they occur within a predetermined time span (col. 5, lines 52-65).

As per claim 9, Watanabe discloses a method of establishing a communication link comprising:

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- contacting a computer network that assigns a first dynamic internet protocol address to a first communication device for a predetermined duration (col. 4, lines 46-67 and col. 5, lines 1-11);
- establishing communication with a second communication device and forwarding the first dynamic internet protocol address from the first communication device to the second communication device via a telephone network (col. 5, lines 41-46);
- terminating the telephone network connection between the first communication device and the second communication device (col. 8, lines 48-53);
- establishing communication with the computer network which reassigns the first dynamic internet protocol address to the first communication device (col. 5, lines 52-65); and
- utilizing the first dynamic internet protocol address for the second communication device to establish communication with the first communication device via the computer network (col. 4, lines 61-67 and col. 5, lines 1-11).

As per claim 10, Watanabe further discloses:

- terminating communication between the first communication device and the computer network after the first dynamic internet protocol address is initially assigned (col. 8, lines 48-53).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of Hjalmtysson et al (hereinafter, "Hjalmtysson", U.S. Pat. No. 6,493,325).

As per claim 1, Watanabe process for effecting communication between at least two communication terminals across a computer network, in which:

- the terminals are linked to a telephone network (see Figure 3 and col. 4, lines 8-22);
- a first terminal connects to the computer network and obtains a first computer address which is transmitted to a second terminal across the telephone network (col. 4, lines 46-67 and col. 5, lines 1-11), and
- the second terminal connects to the computer network and obtains a second computer address which is transmitted to the first terminal across the computer network (col. 5, lines 1-11 and lines 21-31).

However, Watanabe does not explicitly disclose:

- wherein before connecting to the computer network, the first terminal calls the second terminal across the telephone network and invites to call the first terminal back later, and
- as agreed, the second terminal calls the first terminal and first terminal transmit the first computer address to the second terminal, across the telephone network.

Hjalmtysson discloses a method and apparatus for providing telephony over a computer network comprising:

- wherein before connecting to the computer network, the first terminal calls the second terminal across the telephone network and invites to call the first terminal back later (col. 4, lines 43-65, Hjalmtysson discloses sending an invitation to a terminal to initiate a call with another terminal, once the terminal retrieved the encoder/decoder it is able to imitate the call back to the terminal),
- as agreed, the second terminal calls the first terminal and first terminal transmit the first computer address to the second terminal, across the telephone network (col. 4, lines 43-65, Hjalmtysson discloses sending an invitation to a terminal to initiate a call with another terminal, once the terminal retrieved the encoder/decoder it is able to imitate the call back to the terminal).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hjalmtysson's teachings of providing telephony over a computer by sending an invitation to a terminal to initiate a call with another terminal to provide an indirect reference which can be used to conduct a phone call appropriately. Thus, Watanabe provides the motivation to combine by utilizing an internet telephone system that enables communications between terminals over a computer network.

As per claim 2, Watanabe discloses:

- after having obtained the first computer address, the first terminal remains connected to the computer network and is advised of the call of the second terminal across the telephone network by a call signal and then switches

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temporarily over to the second terminal so as to transmit the first computer address to the second terminal across the telephone network (col. 7, lines 64-67 and col. 8, lines 1-16).

As per claim 7, Watanabe discloses the invention substantially as claims discussed above.

However, Watanabe does not explicitly disclose:

- in which the first terminal call the second terminal across the telephone network so as to ask it if the second terminal wishes to communicate with the first terminal across the computer network.

Hjalmtysson discloses a method and apparatus for providing telephony over a computer network comprising:

- in which the first terminal call the second terminal across the telephone network so as to ask it if the second terminal wishes to communicate with the first terminal across the computer network (col. 4, lines 43-65, Hjalmtysson discloses sending an invitation to a terminal to initiate a call with another terminal, once the terminal retrieved the encoder/decoder it is able to imitate the call back to the terminal).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hjalmtysson's teachings of providing telephony over a computer by sending an invitation to a terminal to initiate a call with another terminal to provide an indirect reference which can be used to conduct a phone call appropriately. Thus, Watanabe provides the motivation to combine by utilizing an

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Internet telephone system that enables communications between terminals over a computer network.

As per claim 8, Watanabe discloses:

- in which, after effecting communication between the two terminals across the computer network the each activate a signal so as to advise users that communication has been effected between the terminals (col. 5, lines 52-65).

Response to Arguments

4. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T Jacobs whose telephone number is 703-305-7494. The examiner can normally be reached on 8:30 A.M.-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShonda T Jacobs
Examiner
Art Unit 2157

ltj
March 10, 2005


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